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EXAMINER

MCCORMICK, SUSAN B

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 9

Application Number: 09/939,491

Filing Date: August 24, 2001

Appellant(s): WHITE, ANTHONY ROBIN

Mark P. Bourgeois
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 7, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The Appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

There is only one claim.

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

The grant, no. 4711, published on August 15, 1999 for the Community Plant Variety Office of the European Community with regards to the cultivar 'Avalanche'.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by European Community Plant Breeder's Rights grant no. 4711 (published August 15, 1999) in view of Appellant's admission that 'Avalanche' was sold in the United Kingdom in the fall of 1998 (page 3 of reply filed September 17, 2002). The application requires information pertaining to any prior sale. This document is open to public inspection. This is also evidenced in the UPOV-ROM GTITM Computer Database citation under the

heading "DATE PUBL.GRANT/REG". Additionally, the Appellant, Breeder and Assignee are all listed on this publication. As a result, one of ordinary skill in the art would have known whom to contact to purchase the plant.

The grant was published on August 15, 1999, more than one year prior to filing of the instant application. The grant is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See MPEP § 2128. The Community Plant Variety Office publishes applications for variety protection. Once the Breeder's Grant is made, the variety and description are entered in the Plant Variety Protection Register. The register, grant and published applications are accessible to the public.

A UPOV 'hit', QZ PBR 97/1051, grant publication date August 15, 1999, to a clematis plant 'Avalanche' was found. This date is more than one year prior to the filing date of the instant U.S. application. The published application is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. In the European Community, every two months the Community Plant Variety Office publishes an Official Gazette containing all the information appearing in its Registers, such as applications for protection, proposals for variety denomination and grants of title. Other information the CPVO feels important to the public may also be published in the Gazette. For example, for PBR certificates, UPOV publishes the application number and grant number, date of publication, species of plant and variety denomination, Applicant, Breeder, and Assignee. This information is available on-line as well as in CD-Rom format as of the date listed that the grant/filing was published which in this case was August 15, 1999 and is more than one year prior to filing of the patent application in the United States. Additionally, copies of the grant are obtainable through the Community Plant Variety Office for the European Union. Thus information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992)(“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United

States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publication cited above discloses the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the application, proposed denomination or granted PBR certificate, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. Appellant has admitted that the claimed plant was for sale more than one year prior to application for U.S. patent and thus was in the public domain. As a result, one of ordinary skill in the art could have bought the plant and asexually propagated it, thus reproducing the invention.

(11) Response to Argument

Appellant argues (page 2-3 of brief) that the public use and availability of the subject plant variety outside of the United States is not material to a determination of “plant patentability” of a plant variety in the United States under 102(b). The rejection is based on a printed publication, not public use/on sale. The printed publication bar applies no matter where the publication was made. Public availability of the plant shows that the publication was “enabled”. Applicant’s argument is not persuasive to patentability, as there is no geographic component of enablement. For example, for a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the United States. See *Ex parte Rinehart*, 10 USPQ2d, 1719, (Bd. Pat. App. & Inter. 1989). A printed publication identifying the breeder and assignee of a particular plant in combination with the public availability of the plant places the plant in the public possession. Response in paper number 3, page 3, Appellant admits the invention was “the first sale date was in the United Kingdom in the fall of 1998.”

Appellant argues (page 3 of brief) that it is improper to rely on a combination of references to anticipate the claimed invention under 35 U.S.C. 102(b). Examiner would like to point out that the admission of Appellant that the plant was for sale more than one year prior to application for U.S. patent is not “supplementing” the primary reference, rather the sale of the plant provides proof that the primary reference was enabling. The Examiner would like to point out how the two cited cases support the rejection that was made under 102(b). As noted in *In re Samour*,

“a printed publication which discloses every material element of the claimed subject matter, would constitute a bar under 35 USC 102(b) to appellant's right to a patent if, more than one year prior to appellant's filing date, it placed [the claimed subject matter] ‘in possession of the public.’ Whether claimed subject matter was in possession of the public depends on whether a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the pertinent art.” 197 USPQ at 3-4 (citations omitted).

The court noted that a printed publication that places the invention in possession of the public would constitute a bar under 35 USC 102(b). This language is also used in *LeGrice* as is discussed in further detail below. A printed publication identifying the breeder and assignee of a particular plant in combination with the public availability of the plant places the plant in the public possession.

The court further noted that the disclosure in the primary reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, and that it is appropriate to rely on additional references solely as evidence that, more than one year prior to appellant's filing date, a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the art. 197 USPQ at 4.

Appellant argues (page 4 of brief) that *In re LeGrice* case was concerned with whether or not foreign plant varieties are actually available to the American public. This is incorrect *LeGrice* was concerned with whether printed publications must be enabled to anticipate a claimed invention. In *LeGrice* there is no requirement for access to the plant by Americans. Also, Americans could have purchased the plant and imported it (through quarantine). Biological material is considered available even if it must pass through quarantine. See MPEP 2404.01 (last paragraph). The question in *LeGrice* was whether publications must be enabling to support a rejection under 102(b). The answer was yes, the invention must be in possession of the public. Public use or sale can put the invention in the public domain. Once in the public domain, printed publications are enabled because one can readily obtain the starting materials necessary to make the invention, as set forth in the *Thomson* decision.

Appellant argues (pages 5 and 6 of brief) that "...a new plant variety cannot be anticipated without direct access in the United States to the new plant." Examiner respectfully questions the support for this argument. There is no support for this position in statute or case law. This is not persuasive as in paper no. 3, page 3, Appellant has admitted that the claimed clematis plant was first sold in the United Kingdom in the fall of 1998. The PBR document precisely refers to the species of plant and the name of the plant. Since this plant was sold more than one year prior to the effective filing date of the present application, one skilled in the art would have been able to purchase and propagate the plant "without experiments or further inventive skill". One of even ordinary skill in the art would have been able to reproduce the plant asexually and grow it without experimenting further with the plant in order to obtain the claimed invention. By using the referenced publication, one of skill in the art would have been able to contact the Appellant, Breeder, and Title Holder of the plant in question (information included on the referenced publication) and subsequently obtain a plant since it was being marketed by Appellant's own

admission. Such a plant would thus have been in the public possession due to information in the publication.

Furthermore, except for the type of patent sought, the instant application presents the same fact pattern in *Thomson*. The printed publications cited in *Thomson* were not enabled by Applicant's deposit of seeds **but by the commercial availability of the seeds outside the United States** (emphasis added). As stated in *Thomson*, "we are convinced that the skilled cotton grower would have had the wherewithal, upon reading the publicly disseminated reference articles, to purchase the commercially available Siokra seeds and employ conventional techniques to plant and nurture the seeds to maturity in order to obtain the claimed invention, i.e., Siokra plants, seeds and pollen. It is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokra seeds readily available on the open market." 24 USPQ2d at 1620.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Susan B. McCormick
Examiner
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Susan B. McCormick/sm

June 30, 2003

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